

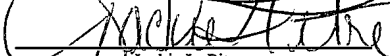
**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**



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Jackie L. Pitre

## 1

**REMARKS**

**New Ground of Rejection under 35 U.S.C. § 101**

In the Examiner's Answer, the Examiner presented a new ground of rejection. The Examiner rejected claim 95 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the Examiner stated:

Claim 95 does not recite a particular apparatus, therefore is rejected under 35 U.S.C. 101, for reciting a non-statutory subject matter.  
(Office Action, page 4)

Appellant respectfully disagrees with the Examiner's rejection. In a recent decision by the Board of Patent Appeals and Interferences (B.P.A.I.), a similar claim was held patentable subject matter under section 101. *See Ex Parte Wasynczuk* (B.P.A.I. June 2, 2008). The claim in question recited "[a]computer-implemented method for simulating operation of a physical system having a plurality of physical subsystems..." *Id.* at 3. After consideration of legal precedent provided by the Supreme Court in several cases, including *Diamond v. Diehr*, 450 U.S. 175 (1981), *Parker v. Flook*, 437 U.S. 584 (1978), and *Gottschalk v. Benson*, 409 U.S. 63 (1972), the Board stated that Appellants' claims are patentable under section 101 because (1) they do qualify as a "process" under section 101, as that term has been interpreted by case law, and (2) they do not seek to patent an abstract idea. *Id.* at 7. The Board further explained that the method steps were tied to a specific apparatus, and not simply a generic computing device performing the steps. *Id.* at 22. The Board determined that because the claims recited a particular apparatus, (1) the method operates on another class of statutory subject matter such that the method is a patentable "process", and (2) the method is not directed to an abstract idea. The Board stated that the claim was directed to a particular machine implementation of the mathematical algorithm that does not encompass every substantial practical application of an abstract idea. *Id.* at 22.

Similar to the claims recited in *Wasynczuk*, claim 95 of the present application recites a specific apparatus, and not simply a generic computing device. For instance, claim 95 recites, *inter alia*:

A method for developing a reinsurance administration system for reinsurance contracts, the method comprising...

Appellant respectfully submits that claim 95 is directed to a method for developing a reinsurance administration system (another class of statutory subject matter), and not an abstract idea. For at least these reasons, Appellant respectfully submits that claim 95 is patentable subject matter under 35 U.S.C. § 101.

### **Rejections under 35 U.S.C. § 103**

Claims 68, 69, 71-77, 79-96, 98-104, and 106-119 are rejected under 35 U.S.C. 103(a) as obvious over U.S. Patent 6,694,506 to LeBlanc et al. (“Leblanc”) in view of U.S. Patent No. 5,946,694 to Copeland et al. (“Copeland”), Pree (Wolfgang Pree, Meta Patterns – A means for capturing the essential of reusable object-oriented design, Proceedings, ECOOP’94, 1994 – info.unikarlsruhe.de, and U.S. Patent No. 6,049,773 to McCormack et al. (“McCormack”).

### **Claim 68**

In the Appeal Brief, Appellant submitted that the Examiner did not appear to provide any prior art reference disclosing a framework that includes a designated order for executing steps in an application program. In response to this argument, the Examiner substantially repeats arguments presented in the final office action. The Examiner stated:

the method of claim 68 would be performed the same regardless of whether the method had a specific type of framework support process, support process, or reinsurance framework. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994). For further guidance, note MPEP § 2106, common

situations involving nonfunctional descriptive material are: "a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention."

(Examiner's Answer, page 7; See also Final Office Action, pages 3-4)

Appellant notes that the current version of section § 2106 of the M.P.E.P. does not appear to contain the language quoted by the Examiner. See M.P.E.P. Rev. 6, September 2007. In any event, the process of claim 68 does not differ from the prior art only "with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed." In *Lowery*, the Federal Circuit stated:

As part of its burden to establish a *prima facie* case of obviousness, see *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed.Cir.1992), the burden of establishing the absence of a novel, nonobvious functional relationship rests with the PTO. "If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *Id.*

With respect to claim 68, the designated order of steps, including the steps of pre-execution, data entry, data validation, pre-commission, commission, and post-commission, are not merely descriptive material because they determine how the steps of the method are carried out when the application programs are executed. As noted above, claim 68 recites in part: "combining one or more reinsurance business process subclasses to build one or more application programs for the reinsurance administration system, wherein the order for executing steps in the one or more application programs is the order for the reinsurance business process framework" and "executing at least one of the one or more application programs for the reinsurance administration system." Appellant submits that the designated order for executing steps in one or more application programs, the steps including pre-execution, data entry, data validation, pre-commission, commission, and post-commission, as recited in claim 68, determines how the steps are carried out when the application program(s) are executed as part of the method. Thus the order for executing steps in one or more application programs, including the steps of pre-

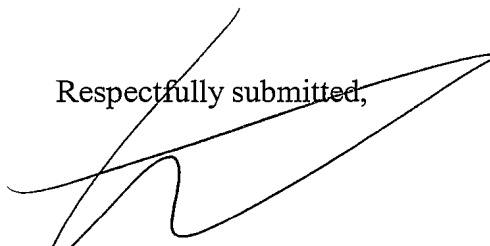
execution, data entry, data validation, pre-commission, commission, and post-commission, are not non-functional descriptive material. For at least these reasons, Appellant submits that the Examiner has not made a *prima facie* case of unpatentability with respect to claim 68.

**VIII. Conclusion**

For the foregoing reasons, it is submitted that the Examiner's rejection of claims 68, 69, 71-77, 79-87, 90-92, 95, 96, 98-104, 106-114, and 117-119 was erroneous, and reversal of his decision is respectfully requested.

If any fees are omitted or if any additional fees are required or have been overpaid, please appropriately charge or credit those fees to Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. Deposit Account Number 50-1505/5053-28301/EBM.

Respectfully submitted,



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